REMARKS

Claims **40, 69, 70, 73 and 74** have been amended. Claims **40, 69, 70, 73 and 74** are independent.

After entry of this amendment, claims **40-74** will be pending in the application.

The 35 U.S.C. 103(a) Rejection

Claims **40-74** have been rejected as being unpatentable over Schneier et al., U.S. Patent No. 5,871,398 (hereinafter "Schneier") in view of Nguyen, U.S. Patent No. 6,857,959 (hereinafter "Nguyen").

Independent claims **40, 69, 70, 73 and 74** have been amended to recite that the indication received from the player concerning an item that the player is interested in winning is made *after receiving the payout information and wherein the payout amount has not been disclosed to the player*. Support for this amendment can be found, for example, in the specification on page 13, line 24 to page 14, line 10, and on page 16, lines 18-19. In addition, claims **40, 69, 70, 73 and 74** have been amended to correct typographical errors and to provide proper antecedent basis for the word "player". In particular, the word "*winning*" replaces the misspelled word "wining" (in line 7 of claims **40, 69 and 74**, line 11 of claim **70**, and line 8 of claim **73**), and the words "*a*" and "*the*" replace the words "the" and "a", respectively (in lines 4 and 5 of claims **40**, **69 and 74**, lines 7 and 8 of claim **70**, and lines 5 and 6 of claim **73**), to provide the proper antecedent basis. No new matter has been added.

Schneier discloses off-line remote lottery systems for lotteries and games of skill, and describes electronic devices that may display graphic renditions of games. But as recognized on page 3 of the Office Action, Schneier does not teach to receive an indication of an item that the player is interested in winning, to determine a value of the item, or to arrange for the player to receive the item. Moreover, Schneier does not disclose to receive the indication of the item that the player is interested in

winning *after receiving payout information and wherein the payout amount has not been disclosed to the player*, which is recited by each of independent claims **40, 69, 70, 73 and 74**.

The Applicants respectfully assert Nguyen does not cure these deficiencies of Schneier. In particular, Nguyen pertains to methods and gaming machines that include a memory storing a list of prizes, a prize display, and a prize selection mechanism that allows a player to select a prize specific to one or more outcomes on the gaming machine (see Nguyen, col. 3, lines 28-35). Nguyen teaches to begin the prize selection process before game play (and thus before any game outcome), wherein a player selects one or more prizes connected to one or more possible game outcomes (see col. 7, lines 30-37). The player chooses one or more prizes from a list, and the prize information may be stored on a magnetic card that is readable by a card reader of the gaming machine. When initiating game play, the player inserts the magnetic card into the card reader of the gaming machine, which reads the prize information and selects an appropriate pay table associated with the selected prizes. The gaming machine then presents game outcomes to the player, and when a specific game outcome corresponding to a selected prize payout occurs, the player wins the selected prize (see col. 11, lines 27-61). Consequently, in all cases Nguyen's system presents game outcomes to the player, which teaches away from *receiving from a device information regarding a payout amount of electronic scratch-off lottery tickets stored on the device, wherein the payout amount has not been disclosed to a player*, and then *receiving from the player an indication, after receiving the payout information and wherein the payout amount has not been disclosed to the player, of an item that the player is interested in winning*, which limitations appear in each of independent claims **40, 69, 70, 73 and 74**. Accordingly, the present claims recite methods and apparatus wherein the game outcomes already exist at the time the player indicates an item that he is interested in winning, and the outcomes are not

disclosed to the player. A lottery provider, for example, may then make a determination concerning whether or not to arrange for the player to receive the selected item based on the payout information. Consequently, we respectfully assert that Nguyen discloses entirely different systems and methods than that recited by the pending claims.

Furthermore, we respectfully submit that there is no teaching or suggestion in either Schneier or Nguyen (or otherwise supported by evidence of record) to combine them. The Examiner must show where the prior art provides a motivation to combine the references that were combined in the obviousness rejection. Absent a motivation to combine, obviousness has not been demonstrated. As noted by the Federal Circuit Court of Appeals:

> "It is insufficient that the prior art disclosed the components of the patented device, either separately or used in combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor ". *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990):

Although Nguyen recites that the gaming machine may be a "lottery game", there is no mention of why one skilled in the art would combine Nguyen's methodology with the off-line remote system for lotteries and games of skill of Schneier. The remote lottery system of Schneier enables players to purchase instant-type lottery game outcomes from a randomized prize data stream in a central computer, and allows the players to view the outcomes on remotely disposed computers without requiring an on-line connection during play (see Abstract of Schneier), whereas Nguyen addresses the problem of how to facilitate the changing of prizes on gaming machines (see col. 2, line 66 to col. 3, line 8 of Nguyen). The applicants respectfully assert that one skilled in the art would not consider Schneier's system when attempting to solve the problem addressed by Nguyen, or vice-versa.

Accordingly, we respectfully submit that the Examiner has failed to point out any teaching, suggestion or incentive in either Schneier or Nguyen for their combination.

Yet further, even if Schneier or Nguyen were combined as suggested, and again there is no teaching or suggestion in either reference for such combination, the present invention as recited by independent claims **40, 69, 70, 73 and 74** would not be the result. In particular, neither of the cited references teaches or suggests to *receive from a device information regarding a payout amount of electronic scratch-off lottery tickets stored on the device, wherein the payout amount has not been disclosed to a player*; and then *receive from the player an indication, after receiving the payout information and wherein the payout amount has not been disclosed to the player, of an item that the player is interested in winning*, as claimed. Accordingly, claims **40, 69, 70, 73 and 74** are patentably distinct over these cited references, taken alone or in combination. Moreover, since claims **41-68 and 71-72** depend either directly or indirectly on claims **40, 69, 70, 73 and 74**, these dependent claims should be allowable for at least the same reasons.

Accordingly, in view of the above remarks, the Applicants respectfully request withdrawal of all of the Section 103(a) rejections and allowance of the present application.

The prior art made of record but not relied upon has not been discussed herein as none of these references have been applied to any of the pending claims

Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested. If there are any questions regarding the present application or the claim amendments, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Stephan Filipek at telephone number 203-461-7252 or via electronic mail at sfilipek@WalkerDigital.com.

We do not believe that any fees are due, but if a fee should be necessary to continue prosecution of the present application, please charge any such required fee to our Deposit Account No. 50-0271. In addition, please credit any overpayment to Deposit Account No. 50-0271.

Respectfully submitted,

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